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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/389,082	09/02/1999	STEPHEN PETER FITZGERALD	104161	4878
25944	7590	08/25/2005		
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			EXAMINER CROSS, LATOYA I	
			ART UNIT	PAPER NUMBER
			1743	

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/389,082

Applicant(s)

FITZGERALD ET AL.

Examiner

LaToya I. Cross

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 6-8-05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17-19 and 22-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-19 and 22-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This Office Action is in response to Applicants' amendments filed on June 8, 2005. Claims 17-19 and 22-38 are pending.

#### *Claim Rejections - 35 USC § 103*

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 17-19 and 22-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matkovich et al in view of Westhall and US patent 6,060,799 to McManus et al.

Matkovich et al teach a device having a plurality of storage wells (20). In one embodiment of the reference, Matkovich et al teach a well having projections (72) on the inner surface of the well (figures 3b and 3c). The projections form a ring around the inner circumference of the well. Matkovich et al teach that the projection serves as a retaining ring. Matkovich et al further teach that inserts (40) may be inserted into the wells and used in assaying a sample for the presence of an analyte of interest. The inserts are substrates capable of binding antibody and other biological substances used in binding assays (col. 3, lines 52-55). Matkovich et al teach that the inserts may be cylindrical inserts with closed tops and bottom, that reside on the bottom surface of the well (col. 7, lines 28-31; col. 9, lines 2-8). When in use, the inserts are located within the well (20) between the base and projection (72). See col. 10, lines 38-45. The reference shows figure 1 as containing multiple wells on a plate. Figure 3c of the reference shows well (20) having a tapered bottom and projection (72). With respect to the method of forming the wells containing chips, Matkovich et al teach that the multi-well plates may be formed by injection molding or other plastic forming process (col. 3, lines 34-38). The inserts are inserted into the wells and may be held in place by projections (72). See col. 8, lines 23-44.

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Matkovich et al differ from the claims of the instant invention in that, while the reference does teach holding binding inserts in the well, there is no disclosure of "chips" being held in the storage wells.

Westhall discloses an apparatus for receiving and storing discs. The discs (3) have biologically active substances bound to it. The discs are equivalent to Applicant's chip. The discs are disposed in a tubular receiving/storage well (2). It would have been obvious to one of ordinary skill in the art to use the storage wells of Matkovich et al as a means to hold and store biochips in a safe manner until time for use.

Matkovich et al further differ from the instant invention in that a square base is not specifically taught (claims 29, 30). Matkovich et al do teach that the wells may be cylindrical or any other hollow shape (col. 3, lines 38-45). It would have been obvious to one of ordinary skill in the art to make the base of the storage well any shape suitable to sufficiently hold the chips within the well.

With respect the chips being "press-fitted" into the wells (claim 22 and its dependent claims), such is conventionally done in injection molding processes. McManus et al teach a magnet being held in a magnet carrier (similar to the chip being held in a storage well). In order to retain the magnet inside the magnet holder, McManus et al teach that during the injection molding process, the magnet is press-fitted to the holder in a frictional engagement. It would have been obvious to one of ordinary skill in the art to "press fit" the chips of Matkovich et al into the storage well to assure that the chips are properly retained.

### *Response to Arguments*

3. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

With respect to Applicants' argument regarding the hot and cold projections being formed after

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the chip is placed in the well, such is not deemed to be patentable since Applicants have not shown that the order of the steps provides unexpected results. MPEP 2144.04 states that the selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results.

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaToya I. Cross whose telephone number is 571-272-1256. The examiner can normally be reached on Monday-Friday 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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*M. J. Cole*  
*Monique T. Cole*  
*Primary Examiner*